

REMARKS

Claims 19 to 22 and 24 are canceled without prejudice, new claims 36 to 41 have been added, and therefore claims 23 and 25 to 41 are now pending.

Applicant respectfully requests reconsideration of the present application in view of this response.

While the objections to claims 26 and 27 as to minor formal matters may not be agreed with, to facilitate matters, claims 26 and 27 have been rewritten, as suggested. It is therefore respectfully requested that the objections be withdrawn.

With respect to paragraph five (5) of the Office Action, Applicant thanks the Examiner for indicating that claims 26 and 27 contain allowable subject matter. While the rejections of the base claims may not be agreed with, to facilitate matters, claims 26 and 27 have been rewritten as independent claims. Claims 19 to 22 and 24 have been canceled without prejudice, since their respective features have been included in their respective base claims. Claims 23, 25, 28, and 30 now depend from claim 26, since their prior base claims were canceled, and claim 29 ultimately depends from claim 26. Accordingly, claims 23 and 25 to 30 are allowable. It is therefore respectfully requested that the objections be withdrawn.

With respect to paragraph two (2) of the Office Action, claims 19 to 22 and 28 to 30 were rejected under 35 U.S.C. § 102(b) as anticipated by “Goodwin et al.”, U.S. Patent Application Publication No. 2002/0194906.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte*

Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine must fail absent the foregoing conditions.

While the rejections of the base claims may not be agreed with, to facilitate matters, claims 26 and 27 have been rewritten as independent claims. Claims 19 to 22 and 24 have been canceled without prejudice, since their respective features have been included in their respective base claims. Claims 23, 25, 28 and 30 now depend from claim 26, since their prior base claims were canceled, and claim 29 ultimately depends from claim 26. Accordingly, claims 23 and 25 to 30 are allowable, and it is therefore respectfully requested that the rejections be withdrawn.

With respect to paragraph two (2) on page 4 of the Office Action, claims 23, 24, and 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over Goodwin et al. in view of “Suzuki et al.”, U.S. Patent No. 5,958,269.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art

reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections of the base claims may not be agreed with, to facilitate matters, claims 26 and 27 have been rewritten as independent claims. Claims 19 to 22 and 24 have been canceled without prejudice, since their respective features have been included in their respective base claims. Claims 23, 25, 28, and 30 now depend from claim 26, since their prior base claims were canceled, and claim 29 ultimately depends from claim 26. Accordingly, claims 23 and 25 to 30 are allowable. It is therefore respectfully requested that the rejections be withdrawn.

With respect to paragraph three (3) of the Office Action, claims 31 to 35 were rejected under 35 U.S.C. § 103(a) as unpatentable over Goodwin et al. in view of Sparks et al., U.S. Patent Application Publication No. 2006/0010964.

The earliest filing date to which the Sparks reference might be entitled (which has not been established) is the July 19, 2004 filing date of provisional patent application serial no. 60/588,669 to which the Sparks reference claims priority. This date is after the November 26, 2003 priority date of the present application. In this regard, the present application claims priority to Austrian Patent Application No. A1895/2003. A priority claim as to Austrian Patent Application No. A1895/2003 was made in the "Declaration and Power of Attorney" submitted on May 25, 2006. The Office has acknowledged receipt of all certified copies of the priority document. A certified English-language translation of Austrian Patent Application No. A1895/2003 accompanies this response. It is therefore respectfully submitted that the Sparks reference is not prior art as to the present application, and that claims 31 to 35 are therefore allowable. Accordingly, withdrawal of the rejections of claims 31 to 35 is respectfully requested.

New claims 36 to 41 do not add any new matter and are supported by the present application, including the Specification. Claims 36 to 41 depend from claim 27, and are therefore allowable for the same reasons as claim 27.

Accordingly, claims 23 and 25 to 41 are allowable.

CONCLUSION

In view of the foregoing, all of pending claims 23 and 25 to 41 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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